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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,187	11/20/2003	Douglas B. Macrae	GS-96 Cont.	9814
75563 7590 08/22/2008 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704				
EXAMINER				
SALCT, JASON P				
ART UNIT		PAPER NUMBER		
2623				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,187

Applicant(s)

MACRAE ET AL.

Examiner

Jason P. Salce

Art Unit

2623

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 7/22/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 7/22/2008 was filed after the mailing date of the Non-Final Rejection on 12/202/2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Election/Restrictions

This application contains claims 21-36 drawn to an invention nonelected without traverse in the reply filed on 9/28/2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Arguments

Applicant's arguments filed 5/20/2008 have been fully considered but they are not persuasive.

Applicant has challenged the examiner's Official Notice and added the claims rejected using Official Notice into the independent claim.

In order to provide evidence to support the Official Notice taken by the examiner, Matthews, III discloses that data corresponding to the data site address comprises commands for controlling recording of the television program (**see Column 12, Lines 9-40**).

At the time the invention is made, it would have been obvious to a person of ordinary skill in the art, to modify the interactive television system, as taught by Shoff, using the recording functionality, as taught by Matthews, for the purpose of saving a program that the viewer has missed and can then view at a later date.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8, 13-18 and 20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shoff et al. (U.S. Patent No. 6,240,555) in view of Matthews, III et al. (U.S. Patent No. 6,025,837).

Referring to claim 1, Shoff discloses a receiver for receiving a television signal including a television program and an address for a data site (**see Figure 2 for television set top box/receiver 26 and Figure 3 for receiving supplemental data with the television program in the form of an Internet data site address**).

Shoff also discloses a decoder for extracting the address of the data site from the television signal (**see tuner 98 in Figure 5 and Column 8, Lines 4-14**).

Shoff also discloses a memory for storing the extracted address and information about the television program (**see memory 94 in Figure 5 and Column 8, Lines 35-41**).

Shoff also discloses a communication device in two-way communication with the data service provider (**see modem 100 in Figure 5 and Column 8, Lines 14-18**).

Shoff also discloses a user input device for receiving user input (**see remote control 30 in Figure 2**).

Shoff also discloses a microprocessor coupled to the memory and the communication device (**see processor 92 in Figure 5**) and configured to store data for an icon representative of the data site address (**see Column 5, Lines 41-43**) and superimposing the icon over the television program on a display device (**see Figure 8a**), to retrieve the data site address and the information about the television program from the memory in response to a user selection, and to control the communication device to retrieve data corresponding to the data site address from the data service provider in response to the user (**see Column 9, Line 30 through Column 11, Line 65**), wherein the television program, the data from the service provider, and the information about the television program are displayed in three non-overlapping regions on the display screen (**see Figures 1, 8b and 8c for displaying all three pieces of information in three non-overlapping regions**).

Shoff fails to teach that the data corresponding to the data site address comprises commands for controlling recording of a television program.

Matthews, III discloses that data corresponding to the data site address comprises commands for controlling recording of the television program (**see Column 12, Lines 9-40**).

At the time the invention is made, it would have been obvious to a person of ordinary skill in the art, to modify the interactive television system, as taught by Shoff, using the recording functionality, as taught by Matthews, for the purpose of saving a program that the viewer has missed and can then view at a later date.

Referring to claim 2, Shoff discloses that the data service provider is an Internet service provider (**see Column 7, Lines 26-35**).

Referring to claim 3, Shoff discloses that the icon includes a textual description of the data corresponding to the data site address (**see Column 5, Lines 34-48**).

Referring to claim 4, Shoff discloses that the microprocessor displays the icon substantially immediately after receiving the data site address (**see Figure 7**).

Referring to claim 5, Shoff discloses a PIP generator, wherein the television program is displayed in a PIP window simultaneously with the information representative of the data site address on the display device (**see Figures 1, 8b and 8c**).

Referring to claim 6, Shoff discloses that the data corresponding to the data site address is purchasing information (see **Figure 8c**).

Referring to claim 8, Shoff discloses that the decoder is a vertical blanking interval decoder (see **Column 10, Lines 28-30 and Column 2, Lines 32-37**).

Referring to claims 13-18 and 20, see the rejection of claims 1-6 and 8, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff et al. (U.S. Patent No. 6,240,555) in view of Matthews, III et al. (U.S. Patent No. 6,025,837) in view of Zavrel (U.S. Patent No. 5,812,930).

Referring to claim 9, Shoff discloses all of the limitation of claim 1, but fails to teach a portable device and wherein the microprocessor is configured to transmit the received data site address to the portable device for storage.

Zavrel discloses a portable device and a microprocessor that is configured to transmit the received data site address to the portable device for storage (**see Column 5, Lines 42-67**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the client equipment system, as taught by Shoff, using the portable device and communication equipment used to allow the portable device to communication with the viewer's television receiver equipment, as taught by Zavrel, for the purpose of providing a device that performs as a standard TV receiver with the additional of a few standard low cost integrated circuits (see Column 6, Lines 5-7 of Zavrel).

Claim 10 corresponds to claim 9, where Zavrel also discloses that the microprocessor transmits the received data site address to the portable device in a wireless manner (**see Column 5, Lines 41-54**).

Claim 11 corresponds to claim 9, where Zavrel also discloses that the portable device includes means for a two-way communication with the data site using the stored data site address (**see Column 5, Lines 55-67**).

Referring to claim 12, see the rejection of claim 10.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/
Primary Examiner, Art Unit 2623

Jason P Salce
Primary Examiner
Art Unit 2623

August 18, 2008